



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,220	09/08/2003	Yoichiro Yamanaka	03547C/HG	2701
1933	7590	08/24/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708			RICKMAN, HOLLY C	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/658,220	YAMANAKA ET AL.	
	Examiner	Art Unit	
	Holly Rickman	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/1/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-27 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-27 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The objection to the specification (i.e changes set forth in the amendment filed 09/28/2004) is withdrawn in view of Applicant's amendments.

Claim Rejections - 35 USC § 112

2. The rejection of claims 28 and 29 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of Applicant's amendments.
3. The rejection of claim 30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn in view of Applicant's amendments.

Claim Rejections - 35 USC § 102

4. The rejection of claims 1-2, 4, 6-7, 9, 11, 15-16, 18, 20-25, and 30 under 35 U.S.C. 102(a) as being anticipated by Takahashi et al. (EPI 174457) is withdrawn in view of Applicant's arguments.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7 and 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze et al. (JP07109363) in view of Markfort et al. (US5451304).

This rejection is maintained as set forth in the prior office action.

7. Claims 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markfort as set forth above for claim 1 , and further in view of Iwasa et al. (JP200158585).

This rejection is maintained as set forth in the prior office action.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markfort as applied to claim 1 above, and further in view of Iwasa (JP200158586).

This rejection is maintained as set forth in the prior office action.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markfort as applied to claim 1 above, and further in view of Iwasa (JP200158583).

This rejection is maintained as set forth in the prior office action.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markfort as applied to claim 1 above, and further in view of Iwasa (JP200158588).

This rejection is maintained as set forth in the prior office action.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markfort as applied to claim 1 above, and further in view of Iwasa (JP200158584).

This rejection is maintained as set forth in the prior office action.

12. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markfort as applied to claim 22 above, and further in view of Tanaka (U56217994)

This rejection is maintained as set forth in the prior office action.

Allowable Subject Matter

13. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments filed 4/22/05 (arguments filed after final and have been entered in response to the RCE filed 6/1/05) have been fully considered but they are not persuasive with respect to the rejections of the claims under 35 USC 103 in view of Kuze et al. as set forth above.

Applicant's arguments with respect to the rejection of the claims under 35 USC 102 in view of Takahashi are persuasive and this grounds of rejection has been withdrawn.

Applicant points out the features of the claimed invention that the references to Kuze et al. and Markfort et al. (with and without additional references of record) fail to disclose.

Applicant references the portions of the previous Office actions where the examiner indicated that these teachings were not explicitly disclosed in the applied prior art. However, Applicant's arguments do not address the examiner's position of record that the limitations of the claims not explicitly taught by the prior art are either inherently taught in the prior art or are obvious over the prior art. For instance, the Applicant notes Kuze et al. and Markfort et al. do not explicitly teach the requirement in claim 1 that the polarity force component be 4×10^3 N/m or less. However, Applicant's arguments do not address the examiner's position of record that the applied prior art necessarily/inherently satisfies this limitation

Applicant further argues that the combination of Kuze et al. and Markfort et al. is not proper because the lamination film taught by Kuze et al. is "substantially different from the electrophoretic coating of Markfort et al." Thus, Applicant argues, one of ordinary skill would not have considered combining the two references. The examiner respectfully disagrees. The two references are directed to coated metal sheets for containers. Thus, one of ordinary skill in

Art Unit: 1773

the art would recognize that the two references are from the same field of endeavor and with appropriate motivation can be reasonably combined.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Holly Rickman
Primary Examiner
Art Unit 1773